

REMARKS

This is a full and timely response to the outstanding final Office Action mailed July 30, 2003. Reconsideration and allowance of the application and pending claims are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 103(a)

A. Statement of the Rejection

Claims 1, 4-24 and 30 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nielson ("Nielson", U.S. Patent No. 6,405,243) in view of Reilly ("Reilly", U.S. Pat. No. 6,427,164).

The Office Action alleges the following:

See at least Figures 1-5 and the description thereof in Nielsen. Nielson teaches in Figure 5 (column 7, lines 6-25) a method for processing sending information in a sending device (101, Figure 1), comprising:

Receiving an entry (recipient's old email address) input by the user into the sending device, the entry comprising sending information that identifies a destination to which information is to be sent by the sending device;

Cross-referencing (see Figure 5) the user-entered sending information with a contacts database that contains recipient sending information of the user to determine if the user-entered information matches sending information saved in the contacts database; and

Automatically catching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved.

Although Nielson refers to the address book as the sender's address book in lines 10-14 of column 7, Nielson does not explicitly state that the sender address book is stored in the sender's sending device. Reilly teaches a sender's address book which is stored in a sending device 110 (see lines 54-58 of column 9 in Reilly). From the teaching of Reilly, it would have been obvious to a person of ordinary skill in the art to store a sender's address book in a sending device such that the address book can be used by the sending machine.

Applicant respectfully traverses this rejection.

B. Applicant's Claimed Invention

Applicant's independent claims are as follows (with emphasis added):

1. A method for processing sending information in a sending device, comprising:
receiving an entry input by a user at the sending device, the entry comprising sending information that identifies a destination to which information is to be sent by the sending device;
cross-referencing the user-entered sending information with a contacts database that contains recipient sending information of the user to determine if the user-entered sending information matches sending information saved in the contacts database; and
automatically caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved.
9. A method for processing sending information in a sending device, comprising:
receiving an entry input by a user at the sending device, the entry comprising sending information, and determining the identity of the user from the entry;
receiving the sending information entered by the user that identifies a destination to which information is to be sent by the sending device;
cross-referencing the sending information entered by the user with a contacts database that contains recipient sending information of the user to determine if the user-entered sending information matches sending information saved for that user;
providing previously saved sending information to the user as a selection option if sending information entered by the user matches the previously saved sending information; and
automatically caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved.
15. A sending information processing system, comprising:
logic configured to receive sending information entered by a user at a sending device that identifies a destination to which electrical information is to be sent;
logic configured to cross-reference the user-entered sending information with a contacts database that contains recipient sending information of the user to determine if the user-entered sending information matches sending information saved for that user in the database; and
logic configured to automatically cache the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved.
20. A sending information processing system, comprising:
means for receiving through entry by a user at a sending device sending information that indicates a destination to which information is to be sent;
means for cross-referencing the user-entered sending information with a contacts database that contains recipient sending information of the user to determine

if the user-entered sending information matches sending information saved in the database for that user; and

means for automatically caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved.

C. Discussion of the Rejection

In order for a claim to be properly rejected under 35 U.S.C. § 103(a), the teachings of the prior art reference must suggest all features of the claimed invention to one of ordinary skill in the art. See, *e.g.*, *In re Dow Chemical*, 837 F.2d 469, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A 1981).

In the present case, not every feature of the claims are represented in the combined references. Below, Applicant addresses the rejection for each of Applicant's independent claims.

1. Independent Claims 1 and 9

Neither Nielson and Reilly, alone or in combination, disclose, teach, or suggest “receiving an entry input by a user at the sending device, the entry comprising sending information” as required by claim 1 (emphasis added). The Office Action cites column 7, lines 6-25 of Nielson as support for anticipating this claim limitation. In particular, the Office action apparently equates the “recipient's old email address” as the “entry input by a user at the sending device.” However, the manner that the recipient's old email address has been included in the sending device is not **by a user at the sending device**. Col. 2, lines 65-67 are illustrative: “The address-change server sends a reply email to the sender with the recipient's updated email address...” As an illustrative example, the sender in Nielson may enter a recipient's email address. If the entered address it is not already saved, the invention disclosed in Nielson does not

disclose, teach, or suggest allowing that email address to be saved by the sender simply by typing in that address at the sending device. In view of this fact, Nielson and Reilly, alone or in combination, clearly do not meet the claimed limitation **“receiving an entry input by a user at the sending device, the entry comprising sending information”** as is now expressed in independent claim 1 and independent claim 9. Therefore, the 35 U.S.C. § 103(a) rejection should be withdrawn from claims 1 and 9 and the claims that depend therefrom.

2. Independent Claim 15

As described above in relation to claim 1 (and claim 9), neither Nielson and Reilly, alone or in combination, disclose, teach, or suggest **“receiving an entry input by a user at the sending device, the entry comprising sending information”** as required by claim 1 (emphasis added). In view of that fact, Applicant respectfully submits that Nielson and/or Reilly therefore at least fail to disclose, teach, or suggest **“logic configured to receive sending information entered by a user at a sending device”** as required by claim 15 (emphasis added).

In view of above, Applicant respectfully asserts that the 35 U.S.C. § 103(a) rejection should be withdrawn from claim 15 and the claims that depend therefrom.

3. Independent Claim 20

As described above in relation to claim 1, neither Nielson and Reilly, alone or in combination, disclose, teach, or suggest **“receiving an entry input by a user at the sending device, the entry comprising sending information”** as required by claim 1 (emphasis added). In view of that fact, Applicant respectfully submits that Nielson and/or Reilly therefore at least fail to disclose, teach, or suggest **“means for receiving**

through entry by a user at a sending device sending information” as required by claim 20 (emphasis added).

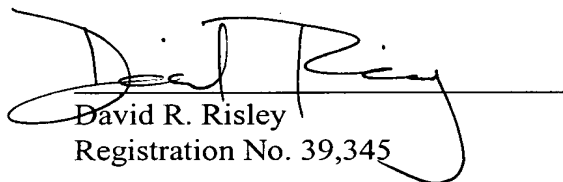
In view of above, Applicant respectfully asserts that the 35 U.S.C. § 103(a) rejection should be withdrawn from claim 20 and the claims that depend therefrom.



CONCLUSION

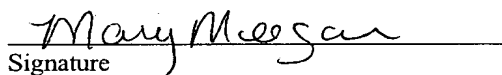
Applicant respectfully submits that pending claims 1, 4-24, and 30 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,


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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Alexandria, Virginia 22313-1450, on

9-30-03


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